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| 09/893,109 | 06/27/2001 | Yoshio Kurokawa | 8373.245US01 | 4901 |
| 23552 | 7590 | 03/23/2004 | EXAMINER | |
| MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903 | | | CHARLES, MARCUS | |
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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/893,109

Filing Date: June 27, 2001

Appellant(s): KUROKAWA ET AL.

MAILED

MAR 23 2004

GROUP 3600

Joshua N. Randall
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08-25-2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the

decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-3 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

07-83290

Japan

03-1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2 are rejected under 35 U.S.C 103 (a). This rejection is set forth in prior office action, paper No. 9.

(11) *Response to Argument*

Applicant's arguments, with respect to the drawing objection and the 112, first paragraph rejection to claim 3 has been fully considered and is persuasive. The objection/rejection has been withdrawn.

In response to applicant's arguments to claims 1 and 2, applicant contended that JP (07-83290) discloses the claimed invention including the metallic roller and the cushion (elastic) roller such that the has an outer diameter larger than that of the metal roller, but does not disclose the relationship of the length of the elastic roller to that of the fix roller such that the elastic roller having a width along an axis of the roller assembly, which is 13-45% of an overall width of the roller assembly along the axis thereof, and the elastic roller having a uniform thickness throughout the width thereof, the thickness of the elastic roller being larger than that a thickness of the rigid roller by 5 to 25% of the thickness of the elastic roller. In addition, applicant also argues that JP '290 does not disclose precisely when effective noise suppression can be obtained and when it cannot. However, applicant clearly states that it is well known in the art to use a metallic roller/elastic roller combination to suppress noise generated when the roller engages the sprocket, and the noise suppression is influenced by the material of the elastic roller (see page 2, lines 19-28). Applicant further states that the claimed

invention has an objective in that due to the ratio of the length of the metallic roller to that of the roller and the ratio of the thickness of the metallic roller to that of the elastic roller noise suppression and durability can be achieved.

In response to applicant's arguments above, the examiner clearly states in the final rejection that the percentage of the ratios of the metallic roller to the elastic roller is not the patentable issue, but the result of the claimed invention. The unexpected result of the claimed invention appears to coincide with that of prior art to JP'290. In the translation provided, JP '290 clearly states that the objective of the invention is to relax the effect of run noise and providing the roller with no inferiority in durability in high speed load operation (see paragraph 007). Therefore, we can conclude that the shock absorber of prior art does not only absorb noise due to impact between the roller and the chain but also indicates that noise suppression and durability is an objective.

In addition, in response to applicant's argument concerning as to when the effective noise suppression can and cannot be obtained. It should be noted that applicant has not defined the term "effective" and one of ordinary skill in the art would consider such term a subjective and relative term. Therefore, an effective result of noise suppression would be defined or determined for each invention of the same category.

For the above reasons, it is believed that the rejections should be sustained.

March 22, 2004

Conferees: *CH*

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Respectively submitted

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